

From: Guiliano, Joseph M. [mailto:JGuiliano@fishneave.com]
Sent: Friday, August 15, 2003 2:53 PM
To: 'Faile, Andrew '
Subject: RE: Harvey Applications

Dear Mr. Faile,

Thank you for the update. I look forward to hearing from you.

Sincerely,
Joe Guiliano

-----Original Message-----

From: Faile, Andrew
To: JGuiliano@fishneave.com
Sent: 8/15/2003 1:23 PM
Subject: RE: Harvey Applications

Mr. Guiliano,

We are still reviewing the request below. I'll get back with you as soon as there is an answer on this.

Sincerely,
Andrew Faile

-----Original Message-----

From: JGuiliano@fishneave.com [mailto:JGuiliano@fishneave.com]
Sent: Thursday, August 07, 2003 1:40 PM
To: Andrew.Faile@USPTO.GOV
Subject: RE: Harvey Applications

Thank you, Mr. Faile. I look forward to hearing from you.

-----Original Message-----

From: Faile, Andrew [mailto:Andrew.Faile@USPTO.GOV]
Sent: Thursday, August 07, 2003 1:28 PM
To: JGuiliano@fishneave.com
Subject: RE: Harvey Applications

Mr. Guiliano,

I have received your email and certainly will consider the points therein. I hope to get back to you with a response by the end of next week.

Sincerely,
Andrew Faile

-----Original Message-----

From: JGuiliano@fishneave.com [mailto:JGuiliano@fishneave.com]
Sent: Thursday, August 07, 2003 12:19 PM
To: andrew.faile@uspto.gov
Subject: Harvey Applications

Dear Mr. Faile,

Thank you for taking the time on Tuesday to discuss the status of the Harvey continuation applications. I have given careful consideration to your proposal to suspend prosecution of the continuation applications in view of the third party reexamination requests that have been filed with respect to several of the issued Harvey patents. I firmly believe that suspension of all of the applications is unnecessary and improper. The advanced state of prosecution of at least two of the 1981-based applications (INTE and MULT) and many of the 1987-based applications should permit prosecution of those applications to continue without interfering with the reexaminations. All of the pending continuation applications are to be treated as "special" under M.P.E.P. Sec. 708.01 by virtue of their effective filing dates. While it is true that reexaminations are to be given priority under M.P.E.P. Sec. 708, that is not a justification for suspending prosecution of an applicant's entire portfolio of related applications. It is particularly inappropriate in this case, where all of the pending applications are to be treated as "special," and where the record for many of the applications is very well developed and ready or almost ready for final disposition.

Moreover, suspension of prosecution is highly prejudicial and fundamentally unfair to applicants. The applications in question have been pending for over eight years. Applicants did not request reexamination of their patents. This burden was placed on the PTO by third parties who are defendants in litigation involving the Harvey patents. Their questions concerning the validity of the Harvey patents could have been addressed by the Courts. In addition, prosecution of many of these applications, including INTE and MULT, has already been suspended once before. Further suspension of these cases would be highly irregular, prejudicial and unfair, especially considering their advanced state.

Furthermore, with respect to the 1987-based applications, these cases do not even raise the Section 120 priority issue that has been a point of contention in the 1981-based cases. During the past few months, replies to recent Office actions have been filed in 17 of the 1987-based cases. These replies include narrative descriptions and detailed claim charts that demonstrate, on an element-by-element basis, that the claims are fully supported by the 1987 specification. The prior art rejections have also been thoroughly addressed (significantly, many claims were not rejected based on prior art). These detailed replies should enable the Examiners to bring closure to these cases in an efficient and prompt manner.

Suspension of the 1981 INTE and MULT applications is also inappropriate. In replies filed early this year, we provided a detailed statement of the law governing the issue of Section 120 priority. Those replies also thoroughly addressed the wholly unsupported "wiggle room", "pledge" and other theories that were improperly relied on by the Examiner to sustain a blanket denial of Section 120 priority for all claims. Significantly, in both cases, we submitted expert declarations of Dr. George T. Ligler, which provide detailed explanations of how both the 1981 and 1987 specifications support the claimed subject matter. Applicants are entitled to responses to these extensive submissions which, given the overwhelming evidence offered by

way of expert declarations and otherwise, should be allowance. If the Examiner believes he can refute this evidence, then these cases are ripe for Board review. Given the advanced state of INTE and MULT, the issue of the blanket rejection of Section 120 priority would be presented to the Board by way of these cases (if agreement cannot be reached) well before similar issues in the reexaminations are presented. Therefore, continued prosecution of INTE and MULT may actually facilitate prosecution of the reexaminations.

While applicants would strongly prefer to also move forward as quickly as possible with prosecution of the other 1981-based applications, we acknowledge that if agreement cannot be reached on the blanket denial of Section 120 priority claims in INTE and MULT, it may be more efficient to obtain Board review of INTE and MULT before proceeding with further examination of the other 1981-based cases. I therefore understand the merits of formalizing the informal agreement we had concerning prosecution of the other 1981-based cases. However, in my view, any formal suspension of the remaining 1981-based cases should terminate once the issue of the blanket priority claim denial is resolved (either by agreement or through Board review). There should be no need to wait for completion of the reexamination proceedings (if they take longer).

For the foregoing reasons, I respectfully request that you reconsider your proposal to suspend prosecution of the Harvey continuations. Instead, please consider our suggestion to move forward with prosecution of the 1987-based applications (particularly those in which replies have been recently filed), and certainly the 1981-based INTE and MULT applications.

In accordance with your request, I have attached an updated chart that reflects the current status of the pending Harvey applications. Please let me know if there is anything further we can provide to advance prosecution of the applications.

Respectfully,
Joseph M. Guiliano
Reg. No. 36,539

<<status.xls>>

Group	Pr.	A/B	Serial No.	Dkt. #	Status
ADVT	87	A	08/488,383	166	Office action mailed 9/6/02
		B	08/475,341	160	Response filed 3/6/03
ASCO	87	A	08/459,521	233	Amendment filed 7/8/02
		B	08/445,054	101	
ASRE	81	A	08/441,701	52	Interview Summary 3/21/02 Withdraws Notice of Non-Responsiveness
		B	08/441,027	53	
BCON	81	A	08/473,484	258	Interview Summary 3/21/02 Withdraws Notice of Non-Responsiveness
		B	08/440,837	59	
BUDG	87	A	08/446,553	104	Amendment filed 7/8/02
		B	08/445,296	105	
CHAN	87	A	08/482,857	311	Amendment filed 7/8/02
		B	08/473,997	364	
CLER	87	A	08/479,374	148	Office Action mailed 9/6/02
		B	08/479,524	54	Response filed 3/6/03
COMB	81	A	08/466,894	276	Amendment filed 3/1/02
		B	08/487,895	191	
DATA	81	A	08/397,636	12	Amendment filed 3/8/02
		B	08/441,996	86	
	87	A	08/480,392	310	Office action mailed 9/3/02
		B	08/487,155	308	Response filed 3/3/03
DECR	81	A	08/449,263	172	Interview Summary 4/18/02 Withdraws Notice of Non-Responsiveness
		B	08/449,413	174	
	87	A	08/474,145	303	Office action mailed 7/31/02
		B	08/485,507	304	Response filed 1/31/03
DIGI	87	A	08/460,711	212	Amendment filed 3/13/02
		B	08/472,462	315	
DOWN	81	A	08/470,051	268	Amendment filed 3/1/02
		B	08/469,106	266	
	87	A	08/460,770	237	Office action mailed 9/25/02
		B	08/460,793	213	Response filed 3/25/03
EMBD	87	A	08/477,711	312	Amendment filed 3/13/02
		B	08/474,496	360	
ERRO	87	A	08/459,788	243	Office action mailed 9/5/02
		B	08/451,377	70	Response filed 3/5/03
FANA	87	A	08/487,411	318	Office action mailed 9/5/02
		B	08/474,674	319	Response filed 3/5/03
HEAD	81	A	08/113,329	8	Interview Summary 4/18/02 Withdraws Notice of Non-Responsiveness
		B	08/442,165	87	

Group	Pr.	A/B	Serial No.	Dkt. #	Status	
I2CM	81	A	08/446,431	150	Interview Summary 3/21/02 Withdraws Notice of Non-Responsiveness	
		B	08/437,045	42		
I2CR	81	A	08/486,258	357	Interview Summary 3/21/02 Withdraws Notice of Non-Responsiveness	
		B	08/447,621	156		
I2GE	81	A	08/511,491	274	Interview Summary 4/18/02 Withdraws Notice of Non-Responsiveness	
		B	08/438,659	43		
	87	A	08/447,712	127	Office action mailed 9/5/02	Response filed 3/5/03
		B	08/487,556	321		
I2RE	87	A	08/477,547	329	Office action mailed 9/5/02	Response filed 3/5/03
		B	08/459,218	256		
IMAG	87	A	08/478,544	306	Office action mailed 1/8/03	Response filed 7/8/03
		B	08/460,081	240		
INTE	81	A	08/470,571	261	Office action mailed 7/17/02	Response filed 1/9/03
		B	08/471,024	299		
METE	81	A	08/452,395	65	Interview Summary 3/21/02 Withdraws Notice of Non-Responsiveness	
		B	08/483,980	66		
MICR	87	A	08/449,097	208		Amendment filed 7/8/02
		B	08/482,574	210		
MKTR	81	A	08/474,964	64	Interview Summary 3/21/02 Withdraws Notice of Non-Responsiveness	
		B	08/480,059	63		
MSG	87	A	08/459,522	238		Amendment filed 7/8/02
		B	08/458,760	217		
MULT	81	A	08/487,526	355	Office action mailed 7/30/02	Response filed 1/29/03
		B	08/437,044	47		
NAUT	81	A	08/477,805	197	Interview Summary 3/21/02 Withdraws Notice of Non-Responsiveness	
		B	08/483,269	307		
	87	A	08/444,758	114		Amendment filed 7/8/02
		B	08/447,611	137		
NAVI	81	A	08/459,216	218	Interview Summary 4/18/02 Withdraws Notice of Non-Responsiveness	
		B	08/480,383	349		
NCOM	87	A	08/460,817	223		Amendment filed 7/8/02
		B	08/460,592	225		

Group	Pr.	A/B	Serial No.	Dkt. #	Status
NECA	87	A	08/487,397	250	Office action mailed 9/6/02
		B	08/449,901	136	Response filed 3/6/03
NGEN	87	A	08/447,447	140	Office action mailed 9/5/02
		B	08/446,124	117	Response filed 3/5/03
OPNS	81	A	08/442,383	74	Amendment filed 3/1/02
		B	08/488,620	354	
	87	A	08/447,908	134	Office action mailed 9/6/02
		B	08/460,394	222	Response filed 3/6/03
POLI	87	A	08/448,251	142	Amendment filed 7/8/02
		B	08/444,787	118	
PROB	87	A	08/483,169	338	Amendment filed 3/13/02
		B	08/486,266	337	
RECO	87	A	08/447,496	121	Office action mailed 9/6/02
		B	08/460,634	246	Response filed 3/6/03
REST	81	A	08/498,002	345	Interview Summary 3/21/02 Withdraws Notice of Non-Responsiveness
		B	08/442,335	88	
SCHE	87	A	08/447,974	145	Amendment filed 7/8/02
		B	08/449,652	146	
SETT	81	A	08/449,523	182	Interview Summary 3/21/02 Withdraws Notice of Non-Responsiveness
		B	08/487,649	344	
SKIP	87	A	08/487,410	314	Office action mailed 8/23/02
		B	08/478,908	313	Response filed 2/24/03
STUD	81	A	08/474,146	186	Interview Summary 3/21/02 Withdraws Notice of Non-Responsiveness
		B	08/483,054	195	
SWIT	81	A	08/469,612	280	Interview Summary 4/18/02 Withdraws Notice of Non-Responsiveness
		B	08/441,577	80	
SYNC	87	A	08/448,644	163	Amendment filed 3/13/02
		B	08/459,507	232	
TELE	87	A	08/472,066	295	Office action mailed 9/6/02
		B	08/479,523	365	Response filed 3/6/03
TRAN	81	A	08/487,536	97	Amendment filed 3/1/02
		B	08/482,573	96	
	87	A	08/445,328	112	Amendment filed 3/13/02
		B	08/447,724	131	
VERI	81		08/444,788	109	Office action mailed 7/30/03
		A	08/448,326	123	Amendment filed 3/1/02
VIEW	81	B	08/447,711	153	
		A	08/485,283	199	Interview Summary 3/21/02 Withdraws Notice of Non-Responsiveness
	87	B	08/470,476	301	
		A	08/479,215	358	Office action mailed 9/5/02

Group	Pr.	A/B	Serial No.	Dkt. #	Status
	07	B	08/487,428	363	